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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/691,806 | 10/21/2003 | Steven P. Barton | 112703-294 | 6662 |

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| EXAMINER | |
|---|---|
| SHAPIRO, JEFFERY A | |
| ART UNIT | PAPER NUMBER |
| 3653 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 03/27/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/691,806 | BARTON ET AL. | |
| | Examiner | Art Unit | |
| | Jeffrey A. Shapiro | 3653 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *44-68,76 and 102-111* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *44-68,76 and 102-111* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/16/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 62-64 is rejected under 35 U.S.C. 102(e) as being anticipated by Terranova (US 6,882,900 B1).

Terranova discloses a point of purchase device (18) in the form of a fuel dispenser that is coupled with a retail purchasing device in the form of quick serve (QSR) menu, as discussed at col. 11, lines 25-35. Regarding obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed, note that it is considered to be inherent that the franchisor in contract with the owner/franchisee of Terranova's gas station would obtain a fee in the form of profits for the owner selling a particular item through Terranova's system, as this is how the current gasoline distribution system operates—i.e., Exxonmobile corporate charges the local operator of the gas station a fee for the gasoline he receives from the refinery for sale at the station. Fees are also paid for use of signs, equipment, and the like. At the least, this is substantially the same structure as Applicant's limitations regarding obtaining fees for

use of vending equipment. Note also the prevalence of usage fees paid to owners of equipment or for use of content in a licensing situation.

Regarding Claim 63, note that the entire point of purchase device is disclosed as being "integral" with the resale purchasing device since the QSR menu is displayed on the fuel dispenser display. See again, col. 11, lines 25-35.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 44-68, 76 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bustos (US 5,816,443) in view of Walter et al (US 5,992,570) and further in view of Terranova (US 6,882,900 B1). Bustos discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 76 and 102-111;

a. allowing a consumer to bring purchasable items to a checkout device (see Bustos, fig. 5a);

b. scanning the items and accumulating a cost for the scanned items on a display (127), as illustrated in Bustos, fig. 1, and fig. 5a, which illustrates a clerk scanning items, and figure 5d, which illustrates a monitor (106);

c. allowing the consumer to select a product (47b) from a dispensing device (20b) located in juxtaposition to the automated checkout (see Bustos, fig. 5a);

d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Bustos, fig 5a); and

e. adding a cost of individual items to the total cost for the scanned items on the display (see Bustos, col. 8, lines 1-49);

Bustos does not expressly disclose, but Walter discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 68, 76 and 102-111;

f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Walter, col. 2, lines 15-19, for example);

gi. allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display; (see Walter, Claim 8, for example);

gii. (68) the point of purchase dispenser is integral with the device that identifies costs-note that Walter discloses scanner (16);

Bustos does not expressly disclose, but Terranova discloses the following.

As described in Claims 44, 47-51, 56, 60-66, 76 and 102-111;

ei. automatically adding a cost of the dispensed product to the total cost of the scanned items on the display.

eii. accepting a single payment for all items, including the dispensed product;

See Terranova, col. 8, line 64-col. 9, line 19 and col. 11, lines 25-35.

As described in Claim 45, 48;

h. use of a touch screen as the display (100);

See Terranova, col. 1, lines 17-20 and col. 7, lines 23-29.

As described in Claims 46 and 104;

i. allowing the customer to pay for the product using a credit/debit card or cash;

See Terranova, col. 1, lines 47-50.

As described in Claims 49, 50, 52, 53, 56, 57, 65

j. advertising/prompting a customer to add a dispensable product to their purchase;

See Terranova, col. 8, line 64-col. 9, line 19.

Regarding Claim 53, note that Terranova discloses advertising, but does not specify the time period at which it is presented. However, note that the group of time periods presented in Claim 53 covers all conceivable time periods with respect to the transaction. Therefore, since Terranova discloses presenting advertisements with respect to the transactions, Terranova is considered to meet Claim 53.

Further regarding Claims 54, 55, 58, 59 and 106, note that it would have been obvious for either an operator to substitute for a customer in operating the machine, taking verbal instruction from said customer, or for the customer himself to perform the task.

Regarding Claim 60, note that Terranova discloses purchasing items at a convenience store, which is considered to include both consumables, such as food, as well as non-consumables, such as lighters and windshield scrapers. Note also that a food item that is not consumed, becomes a non-consumable item.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Bustos with the checkout counter of Walker.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Further, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated the interface having the features discussed above, as taught by Terranova, in Bustos' checkout counter with dispenser, so that a customer using Bustos' self-checkout would be able to dispense an item, the cost of which was automatically added to the total of all items purchased at the checkout counter.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Note also that Bustos provides motivation and teaching for locating an item dispenser at a checkout counter/point of sale (POS).

Walter provides teaching to use a self checkout system in place of a traditional checkout counter with clerk/operator.

Terranova discloses an interface for a customer operated point of sale device which promotes and allows the customer to purchase other items/services at the single POS device.

Based on these teachings, one ordinarily skilled in the art would have found it obvious to incorporate Bustos' dispenser and checkout counter as a self-checkout counter having a display which displays a user interface allowing purchase of the dispensed items during the purchase transaction of other items that have been scanned.

Therefore, the combination of Bustos, Walter and Terranova are considered to read on Applicant's claims as discussed above.

***Response to Arguments***

5. Applicant's arguments filed 3/7/07 have been fully considered but they are not persuasive.

Regarding Claim 44, Applicant argues that Bustos teach away from an automated checkout with the product located/stored and dispensed in juxtoposition to

the checkout itself. Applicant's newly added claim limitations simply state "storing the product to be dispensed in the dispensing device". Bustos' storage area is connected by pipe to the outlet from which the item is delivered to the customer. This structure is all considered part of the dispenser. Therefore, Applicant's newly added claim language is considered to be met by Bustos. The same is true of Terranova.

Again, regarding the terms "remote" and "proximate", these terms are relative terms. In relation to Bustos or Terranova, the items located in the storage areas are construed to be proximate since they are in the same building, in Bustos case, and proximate the fuel pumps in Terranova's case. Either way, even if it was construed that they were not proximate, it would have been obvious to do so since the size of the conduit through which the items travel is a matter of design choice based on situational requirements. Terranova still teaches the concept of adding the cost of the dispensed product to the total cost of the customer's bill.

Regarding Claims 48, 102, and 106-111, Terranova does disclose use of a touch screen. Applicant appears to misread the passage at col. 7, lines 23-29. A key pad is well-known to be a set of keys in the form of a keyboard. A touch interface, however, can only be integrated with the display to form a touch interface in the implementation of a touch screen. This is also considered the more likely interpretation since the passage previously mentions the keyboard/keypad as adjacent to the display. Additionally, Terranova at col. 1, lines 17-20 refers to "user interfaces with large displays and touch-pads or screens" as being typical in fuel dispensers, which further buttresses the

interpretation of Terranova's touch screen interface to be a touch screen as called for in Applicant's claims.

Regarding Claim 49, Walter, as admitted by Applicants, does disclose a customer prompt. Since this is in part what the teaching of Walter is used for, the fact that it prompts for any product can be construed to include products located anywhere in the store, either at the point of purchase or far away therefrom.

Regarding Claim 50, Terranova, at col. 8, line 64-col. 9, line 8, discloses a prompt for items able to be dispensed at the fuel dispenser. The media presentations and displays described by Terranova are considered to meet the limitations of a means to prompt the consumer that "the product is available at the point of purchase."

Regarding Claims 56, 65, 76 and 106, Bustos discloses various items stored and dispensed. Note in figure 4a, b, a soda bottle is dispensed, while in figure 4c, a hotdog is being dispensed. Even if it were considered not disclosed, at the very least, it would be considered obvious to prompt the customer it buy any number of items able be dispensed by Bustos' dispenser because the intent of Bustos' dispenser is to sell items, and this would have been an obvious way of bringing such items to the attention of the customer for purchase. This combined with Terranova's teaching at col.9, lines 4-8 to "provide a video menu at the display to facilitate selection of various services, goods and food available for purchase." Again, note that Applicant's Claims 56, 65, 76 and 106 can be construed to read on Bustos and Terranova since both Bustos' and Terranova's dispensers store items, and dispense them at the point of purchase. The

nozzle in Terranova's device can be construed to dispense items at the point of purchase as is Bustos' product exit (20b) illustrated in figure 5a.

Further regarding Claims 106 and 109, Terranova teaches advertising/prompting a customer to add a dispensable product to their purchase at col. 8, line 64-col. 9, line 19. Note col. 8, lines 64-67 which specifically mentions audio/video electronics (86, 156) that provides "advertising, merchandising and multimedia presentations to the customer". Such advertising and multimedia presentations are construed as being of a dynamic nature, as the definitions of these terms so suggest, especially when used in proximity to each other.

Regarding Claim 110, note again that it would have been obvious in light of both Bustos and Terranova to dispense any conceivable product that one ordinarily skilled in the art would consider customers would like to purchase in their dispensers so as to provide profit. Gum or candy is just such an item. Also, gum or candy is well-known to be bought and sold in vending machines and at gas stations/convenience stores such as Bustos' or Terranova's.

Again, regarding Claims 62-64, Applicants assert that charging a fee for the gasoline dispensed is not considered to be inherent in the gasoline distribution industry. Terranova's system is intended to be an operating part of the gasoline distribution industry. It is well-known that the fee structure of the gasoline industry involves a particular fee the gasoline station owner pays the corporate entity which supplies him with product from refineries. Note also that a gasoline station can be construed as a "retail outlet". Additionally, note that franchise fees are inherent business structures

wherein a franchisee pays licensing fees to a franchisor for use of the tradename and equipment as well as supplies to create and/or sell to the public.

Therefore, Claims 44-68, 76 and 102-111 are rejected.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ginter, US 2002/0112171 A1 is cited at paragraphs 2180, 2182, 2184 and 2187 as an example of usage fees. http://en.wikipedia.org/wiki/Franchising is cited as including the definition of "franchising".

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is

(571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAS
March 13, 2007

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